<u>REMARKS</u>

This application has been reviewed in light of the Office Action dated

April 22, 2004 and the Advisory Action dated October 26, 2004. A Request for Continued

Examination is filed herewith. Claims 31-34, 36, 37, 39-50, 55 and 56 are presented for

examination, of which Claims 31, 55 and 56 are in independent form. Favorable

reconsideration is requested.

Claims 31-33, 36, 37, 39-41, 43, 49, 50, 55 and 56 stand rejected under 35

U.S.C. § 102(e) as being anticipated by U.S. Patent 4,720,707 ("*Konishi*"), and Claims 34,

42 and 44-48 stand rejected under 35 U.S.C. § 103(a) as being obvious from *Konishi* in

view of U.S. Patent 4,670,791 ("*Murata*").

Claim 31 recites an information processing apparatus including obtaining

means for obtaining an image by scanning a sheet, character recognition means for

obtaining character data from the image by performing character recognition on the image,

and determining means for determining types of the character data obtained by the

character recognition means. A display controller controls a display of the image together

with the character data arranged in a plurality of frames corresponding to each of the types

determined by the determining means. A memory is provided for storing the image

together with the character data in the corresponding frame for each type.

Konishi relates to a display apparatus in which plural erasable images

formed on an image bearing member are transported to a display mechanism and displayed

simultaneously thereon. The image bearing member moves along a determined path, along

which are provided stations for image formation, display and erasure.

It is respectfully submitted that nothing in *Konishi* teaches or suggests obtaining character data from a scanned image by performing character recognition on the image, in the manner of Claim 31.

The Examiner has taken the position that *Konishi* discloses character recognition, either expressly or inherently, but Applicants respectfully submit that this position is wrong, both as a matter of law and fact. The Examiner's position is wrong as a matter of law, because the Examiner has not explained why the feature in question is necessarily present in *Konishi*.

> In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

M.P.E.P. § 2112(IV) (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). The Examiner states at page 2 of the Advisory Action that "if *Konishi* can place the scanned images (specification and drawing) at different memory locations, that means it can recognize the 'character.'" But to begin with, as explained below, this is not necessarily the case (and thus a rejection based on inherency is improper), and indeed, the system of *Konishi* as described in that patent actually functions substantially differently than hypothesized by the Examiner.

As explained in *Konishi*, if the specification and drawings of a patent are to be viewed simultaneously and stored in separate memory areas, *Konishi* makes clear that they must be placed by the user onto two separate input belts (one for the specification and one for the drawings):

> FIG. 10 shows the state of displayed images, wherein a first
> image I1 formed on the first belt 109A and a second image I2
> formed on the second belt 109B can be simultaneously
> observed on the display unit. If said first image I1 is the
> image of the first page of a patent specification describing
> FIG. 1, and said second image I2 is the image of said FIG. 1,
> it is rendered possible for the operator to read the description
> while making reference to the corresponding illustration.

Konishi at col. 10, lines 32-40. Thus, character recognition is not necessary to the system

of *Konishi* and is in fact not present in that system.

Finally, it is respectfully submitted that the Examiner's position is

fundamentally implausible, as it would require the system of *Konishi*, not only to perform

character recognition, but also to be able to distinguish between a text and drawings.

Konishi does not even hint at this sort of functionality, and one of ordinary skill in the art

would understand that such functionality in fact is not present in *Konishi*.

For all these reasons, it is believed to be clear that Claim 31 is allowable

over *Konishi*.

Independent Claims 55 and 56 are method and computer memory medium

claims, respectively, corresponding to apparatus Claim 31, and are believed to be

patentable for at least the same reasons as discussed above in connection with Claim 31.

A review of the other art of record, including *Murata*, has failed to reveal

anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed

above, as a reference against the independent claims herein. Those claims are therefore
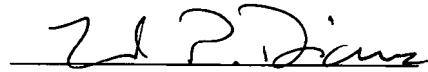
believed patentable over the art of record.

The other claims in this application are each dependent from independent

Claim 31, and are therefore believed patentable for the same reasons. Since each

dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

Leonard P. Diana
Attorney for Applicants
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 477514v2